REMARKS

Claims 1-18 are now in the application. By this Amendment, claims 4, 11, and 16 have been amended. No new matter has been added.

Claims 4, 11, and 16 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite because these claims are considered to not further limit the scope of the claims from which they respectively depend. Claims 4, 11, and 16 have been amended to obviate this rejection.

Claims 1-18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,792,719 to Eberle et al. in view of US 3,506,630 to Beier et al.

As appreciated by the Examiner, Eberle fails to teach a binder dispersion comprising a copolymer consisting essentially of an α-olefin whose α-olefin content is from 37 to 30 mol% and a vinyl-C_2-C_4-carboxylate whose vinyl-C_2-C_4-carboxylate content is from 63 to 70 mol%, as recited in claim 1. Similar subject matter is recited in independent claims 10 and 15. The Office Action relies on Beier for curing the deficiencies of Eberle.

Beier suggests, at col. 2, lines 48-59, copolymerizates of ethylene and vinyl acetate, containing from 30 mol-% to 80 mol-% of ethylene. However, the actual working examples contain from 36 % by weight of ethylene (example 1) to 41 % by weight of ethylene (example 4), which corresponds to 83 mol-% to 68 mol-% of ethylene (given a molecular weight of ethylene of 28.05 g/mol and a molecular weight of vinyl acetate of 86.09 g/mol). In other words, Beier suggests an ethylene content that is nowhere close to the narrow and well defined range recited in the independent claims. Accordingly, a skilled person reworking the disclosure of Beier will not be directed to an embodiment falling within the range recited in the independent claims.

Applicants note that the working examples of Eberle use a copolymer of vinyl acetate and vinyl laureate, without giving any specifics about the relative amount of the two monomers. See col. 4, line 66, to col. 5, line 1.

Moreover, Beier suggests, at col. 2, lines 13-15, that it is an object of the invention therein to obtain copolymerizates that form clear, blob-free solutions in organic solvents. In all of the polymerization recipes of Examples 1 through 7, the copolymer is dissolved in "normal" organic solvents. To this end, the copolymers of ethylene and vinyl acetate are isolated from the aqueous dispersion (see col. 3, lines 46 to 48) and dissolved in esters, aromatic solvents, ketones, and chlorinated hydrocarbons (see col. 3, lines 53 to 68). In stark contrast, independent claims 1, 10 and 15 recite an aqueous binder dispersion.

The Office Action asserts, at paragraph 16, that the H_2 consumption recited in claim 18 is an inherent or obvious property. It is not understood what is meant by a property being obvious. With regard to inherency, the cases referred to in MPEP §2112, on which the Office Action relies, are directed to a single prior art citation to assess whether or not a product or a process inherently possesses a property. Here, the Office Action picks and chooses features from two references based on the roadmap provided by Applicants, attempting to find support for the combination of all of the features of claim 1, and then asserts that the combined teachings inherently possess all of the properties of a catalyst, as claimed.

It is noted that the catalyst used in Eberle employs a vinyl acetate/vinyl laurate organic binder. Beier suggests rubber-like polymerizates that are suitable as adhesive substances, coatings and rubberlike articles. As set forth at col. 3, line 71 to col. 4, line 3, the copolymerizates are particularly useful for use with resins, such as cumarone-indene resins. Beier fails to suggest using the copolymerizates as binder compositions. In other words, neither applied citation describes a binder composition as claimed which would inherently result in a catalyst having a H_2 consumption as claimed. However, as mandated by legal precedence, inherency requires that the recited result or structure must necessarily be obtained not merely that it might be achieved. See *Electra Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 32 USPQ2d 1017 (Fed. Cir. 1994); *In re Oelrich*, 212 USPQ 323 (CCPA 1981) and *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999).

As set for the in MPEP §2112 (IV), "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the

determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). This burden has not been met in the Office Action.

The Office Action asserts that a skilled artisan would utilize the catalyst taught in Eberle, replace the vinyl acetate/vinyl laurate binder with the copolymerizate of Beier, change the relative percentages of ethylene used in Beier from 36 to 41 mol % to 63 to 70%, replace the organic solvent with water and, thus, necessarily produce a catalyst that inherently has a H_2 consumption as claimed.

Following the reasoning in the Office Action, unexpected results may never be sufficient to demonstrate patentability if all of the features of a claim may simply be picked and chosen from various embodiments disclosed in separate applied citations and combined based on the roadmap provided in the application.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicants concurrently herewith submit the requisite fee for a Petition for a one-month Extension of Time. Applicants believe no additional fee is due with this response. However, if any such additional fee is due, please charge our Deposit Account No. 22-0185, under Order No. 13111-00031-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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